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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/556,014

11/02/2006

Clint Chapple

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757 7590 01/05/2010
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EXAMINER

PAGE, BRENT T

ART UNIT

PAPER NUMBER

1638

MAIL DATE

DELIVERY MODE

01/05/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/556,014 | Applicant(s) CHAPPLE ET AL. | |
| | Examiner BRENT PAGE | Art Unit 1638 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8 and 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Reply filed by Applicant on 09/14/2009 is hereby acknowledged. Claims 8 and 10-16 are pending and are examined herein on the merits.

Claim Rejections - 35 USC § 102

Claims 1-16 remain rejected under 35 U.S.C. 102(e) as being anticipated by Nikolau et al (US20020162137). The claims remain rejected for the reasons of record set forth in the office action mailed out on 02/26/2009 as well as the reasons set forth below.

Applicant's arguments filed 07/27/2009 have been fully considered but they are not persuasive.

Applicants urge that that cited art does not meet all of the claim limitations, specifically the reduced sinapine content or that reducing the expression of REF1 would result in reduced sinapine content (See pages 4-5 of response).

This is not persuasive because the reduction in sinapine content is an inherent property that would result in a plant that is transformed with a construct that reduces the expression of REF1. If all of the method steps of the invention are anticipated, then the invention is anticipated as a result. As mentioned in the previous office action, Nikolau et al teach the transformation of plants with antisense oriented constructs comprising SEQ ID NO:21 which would reduce the expression of that sequence which is 99.2% identical to SEQ ID NO:1 of the instant invention which is considered to be a REF1 gene. Applicants have not provided evidence that the cited paper does not incorporate

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a REF1 gene and therefore the reference still anticipates the claims as currently written. Because Nikolau et al teach the transformation of a plant with an expression construct that reduces the expression of REF1 and the growth of the resultant plant, the resultant reduction in sinapine content is an inherent property.

Claim Rejections - 35 USC § 103

Claims 1-16 remain rejected under 35 U.S.C. 103(a) as being obvious over Nikolau et al (US20020162137) in view of Keller et al (US Patent 6703539). The claims remain rejected for the reasons of record set forth in the office action mailed out on 02/26/2009 as well as the reasons set forth below.

Applicant's arguments filed 07/27/2009 have been fully considered but they are not persuasive.

Applicants urge that it was not known that decreased expression of REF1 in plants resulted in plants with reduced sinapine content and that the present invention therefore demonstrates unexpected results (see pages 6-7 of response).

This is not persuasive because the constructs of the instant claims do not differ from the constructs in the prior art. In response to applicant's argument that the reduction in sinapine content was not known in the prior art, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it

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meets the claim. In order to obviate the rejection of record the claimed method must have a positive recitation of measuring sinapine content to distinguish the instant method from that of the prior art. Care must be taken to avoid introducing New Matter into the claims.

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRENT PAGE whose telephone number is (571)272-5914. The examiner can normally be reached on Monday-Friday 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571)-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brent T Page

/Cynthia Collins/
Primary Examiner, Art Unit 1638